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TRANSMITTAL OF APPEAL BRIEF

Docket No.
65678-0042

In re Application of: Aaron J. Bly et al.

Application No. 09/990,911-Conf. #4207	Filing Date November 14, 2001	Examiner C. L. Hewitt	Group Art Unit 3621
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Invention: SYSTEM AND METHOD FOR DISPOSING OF ASSETS

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: March 16, 2005.

The fee for filing this Appeal Brief is \$ 500.00.

Large Entity Small Entity

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Dated: May 5, 2005

Appeal Brief Transmittal

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FEE TRANSMITTAL		Application Number	09/990,911-Conf. #4207
For FY 2005		Filing Date	November 14, 2001
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		First Named Inventor	Aaron J. Bly et al
TOTAL AMOUNT OF PAYMENT (\$) 500.00		Examiner Name	C. L. Hewitt
		Art Unit	3621
		Attorney Docket No.	65678-0042

METHOD OF PAYMENT (check all that apply)

<input type="checkbox"/> Check	<input type="checkbox"/> Credit Card	<input type="checkbox"/> Money Order	<input type="checkbox"/> None	<input type="checkbox"/> Other (please identify): _____
<input checked="" type="checkbox"/> Deposit Account Deposit Account Number: 18-0013 Deposit Account Name: Rader, Fishman & Grauer PLLC				

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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

<u>Application Type</u>	<u>FILING FEES</u>		<u>SEARCH FEES</u>		<u>EXAMINATION FEES</u>		<u>Fees Paid (\$)</u>
	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEESFee Description

Each claim over 20 (including Reissues)

50 25

Each independent claim over 3 (including Reissues)

200 100

Multiple dependent claims

360 180

<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>
_____	_____	_____	_____	<u>Fee (\$)</u> <u>Fee Paid (\$)</u>

<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	_____	_____
_____	_____	_____	_____	_____	_____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
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4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

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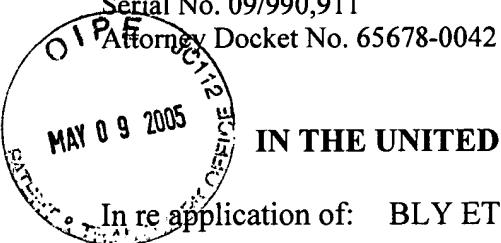
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Fee Transmittal

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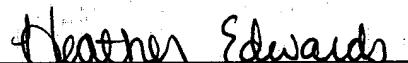
Serial No. 09/990,911
Attorney Docket No. 65678-0042

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: BLY ET AL.

Serial No.: 09/990,911 Group Art Unit: 3621
Filed: 11/14/2001 Examiner: HEWITT II, Calvin L.
For: SYSTEM AND METHOD FOR DISPOSING OF ASSETS
Attorney Docket No.: 65678-0042

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Heather Edwards Name	
Date: May 5, 2005	

APPEAL BRIEF

Dear Sir:

This appeal is from the decision of the Primary Examiner dated December 17, 2004 (“Final Office Action”), finally rejecting claims 1-23, which are reproduced as an Appendix to this brief. The Notice of Appeal was filed on March 16, 2005. This application was filed on November 14, 2001. Submitted herewith are two additional copies of this Appeal Brief.

I. REAL PARTY IN INTEREST

The Real Party-In-Interest is Dana Corporation, located at 4500 Dorr Street, P.O. Box 1000, Toledo, Ohio 43697. Dana Corporation was assigned all rights to the U.S. Patent

Application identified by Serial No. 09/990,911 on May 15, 2003 by Dana Commercial Credit Corporation of 660 Beaver Creek Circle, Maumee, Ohio 43537.

II. RELATED APPEALS AND INTERFERENCES

On July 9, 2003, Appellant filed a notice of appeal, and on September 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/441,289. On January 7, 2005, this Board issued a decision reversing the Examiner's rejection of all pending claims (claims 16 and 21-48). Pursuant to 37 C.F.R. § 41.37(c)(1)(ii), a copy of the afore-mentioned decision of this Board is attached hereto as Appendix B. The application at issue in this appeal is a C-I-P application claiming priority from application 09/441,289.

On July 9, 2003, Appellant filed a notice of appeal, and on September 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/504,000, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. The application at issue in this appeal is a C-I-P application claiming priority from application 09/504,000.

On October 9, 2003, Appellant filed a notice of appeal, and on December 9, 2003 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/504,343, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. The application at issue in this appeal is a C-I-P application claiming priority from application 09/504,343.

On October 24, 2003, Appellant filed a notice to appeal the final rejection of U.S. Application Serial Number 09/503,671, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. On November 25, 2003, after Appellant had filed the afore-mentioned notice of appeal, the Office mailed a new final rejection of all claims. In response, Appellant submitted an Amendment Pursuant to 37 C.F.R. §1.116 and a Notice of Appeal, both dated January 20, 2004. An Advisory Action was mailed on February 2, 2004. Appellant subsequently filed an Appeal Brief on April 20, 2004. The application at issue in this appeal is a C-I-P application claiming priority from application 09/503,671.

On December 12, 2003, Appellant filed a notice of appeal, and on February 12, 2004 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No.

09/702,363, filed October 31, 2000 as a C-I-P application claiming priority from application 09/441,289. The application at issue in this appeal is a C-I-P application claiming priority from application 09/702,363.

On December 12, 2003, Appellant filed a notice to appeal, and on February 12, 2004 Appellant filed an Appeal Brief, appealing the final rejection of U.S. Application Serial Number 09/653,735, filed September 1, 2000 as a C-I-P application claiming priority from the following applications: U.S. Application Serial No. 09/441,289 filed November 16, 1999; U.S. Provisional Application Serial No. 60/166,042 filed November 17, 1999; U.S. Application Serial No. 09/503,671 filed February 14, 2000; U.S. Application Serial No. 09/504,000 filed February 14, 2000; and U.S. Application Serial No. 09/504,343 filed February 14, 2000. On April 26, 2005, this Board issued a decision reversing the Examiner's rejection of all pending claims (claims 1-8 and 12-24). Pursuant to 37 C.F.R. § 41.37(c)(1)(ii), a copy of the afore-mentioned decision of this Board is attached hereto as Appendix C. The application at issue in this appeal is a C-I-P application claiming priority from application 09/653,735.

On May 4, 2004, Appellant filed a notice to appeal, and on July 1, 2004 Appellant filed an Appeal Brief, appealing to the final rejection of U.S. Application Serial No. 09/714,702, filed November 16, 2000 as a C-I-P application claiming priority from application 09/441,289. The application at issue in this appeal is a C-I-P application claiming priority from application 09/714,702.

III. STATUS OF CLAIMS

Claims 1-23 are pending, and are the subject of this Appeal. Claims 1, 17, and 21 are independent claims. No claims have been amended during prosecution of this patent application.

In the Final Office Action, claims 1-23 were rejected under 35 U.S.C. § 101 for allegedly failing to recite statutory subject matter. Claims 12, 17, and 22 were rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Claims 1-23 were rejected under 35

U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent No. 6,067,525 ("Johnson") in view of U.S. Patent No. 6,236,990 ("Geller").¹

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection. A copy of all claims on appeal is attached hereto as an Appendix.

V. SUMMARY OF THE INVENTION

An electronic system is provided for facilitating transactions, particularly rental transactions. The electronic system provides, in effect, a "virtual" rental fleet available to a user of the system, such as a dealer. The system includes an asset configuration unit, a market database, a market search module, and a communications interface. (Specification, page 4, lines 18-24.)

The configuration unit is responsive to input data, provided by a first user of the system, for generating a profile of an asset. The asset profile comprises asset specification data and a bid definition. In a preferred embodiment the bid definition outlines parameters associated with a rental transaction of the asset. The market database is configured to store a plurality of asset profiles. The market search module is configured to search the market database, based on search parameters specified by a second user, and generate an identification of assets. The bid module is configured to allow the second user to select one of the assets on which to bid. The bid module is also adapted to provide rental options to the second user, based on the bid definition for the asset. Finally, the communications interface is configured for facilitating the electronic remote access by the second user of the system. (Specification, page 4, line 25 – page 5, line 7.)

Accordingly, a dealer or the like is provided access to a "virtual" rental fleet of assets, some of which are not owned or controlled by the dealer. The system allows a user, such as a dealer, to satisfy the requirements of the dealer's end-user customer without having to maintain infrequently used items in the dealer's own rental fleet (which experience low utilization rates

¹ Paragraph 7 of the Final Office Action does not initially identify Geller as a basis for the Section 103 rejection of claims 1-23. However, inasmuch as the Examiner acknowledged certain deficiencies of Johnson in the body of the rejection and allegedly cures these deficiencies with Geller (see Final Office Action, page 7), it is clear that claims 1-23 in fact stand rejected as unpatentable over Johnson in view of Geller.

and thus low returns on investment.) Additionally, the electronic system also allows a user, such as a dealer having its own under-utilized assets, to consign assets for rental by third parties, thereby allowing an increased, effective utilization rate. (Specification, page 4, lines 8-18.)

Further, an electronic system is provided for facilitating transactions, including, for example, asset disposal transactions. The system, according to this aspect of the present invention, provides detailed information concerning an asset, including the maintenance history data so that the user, a potential purchaser, rentee or lessee, may evaluate the asset. The system includes a first database, a market search module, and a communications interface. (Specification, page 5, lines 19-26.)

In a preferred embodiment, the first database is configured to store information associated with a plurality of assets, such as pieces of industrial equipment. The market search module is configured to search the first database, based on search parameters specified by the user in anticipation of at least one of a purchase, rental and lease transaction. The market search module is also adapted to generate an identification of assets in accordance with the specified search parameters. At least one of the identified assets has a description that includes maintenance history data of the asset. The communications interface is configured to facilitate electronic remote access of the system by the user, which, in one embodiment, occurs over the Internet. (Specification, page 5, line 27, page 6, line 6.)

The electronic system then maximizes value extraction related to the asset by making detailed information concerning the asset readily available to the user. In particular, the maintenance history of the asset constitutes information that may increase the price obtained for the asset. For example, the maintenance history data is particularly important to a dealer class of users of the system who anticipate sub-renting or sub-leasing the asset for a short term, inasmuch as a common commercial practice places the responsibility of maintenance on the dealer, not the end-user customer. Availability of information such as maintenance history data electronically, and immediately, substantially minimizes or eliminates the cost associated with information acquisition. (Specification, page 6, lines 7-20.)

In a refinement of the proposed asset disposition, a subsystem is disclosed, which compares a subset of all assets within the system with a series of pre-defined conditions to determine if an action needs to be taken with respect to asset disposition. If a pre-defined

condition is met, the system provides a ranked hierarchy of options based on the pre-defined condition that has been met. Associated with each option is the cost of invoking it, and the reasons why it is recommended for consideration. The hierarchy of options and the option determination assumptions are optionally reviewed and then presented to the asset user for consideration. (Specification, page 6, lines 21-32.)

V. ISSUES

1. Whether claims 1-23 are patentable under 35 U.S.C. § 101.
2. Whether claims 12, 17, and 22 are patentable under 35 U.S.C. § 112.
3. Whether Johnson teaches or suggests “a set of predefined conditions” as required by claims 1, 17, and 21 (and therefore by each of claims 1-23).
4. Whether the Examiner stated a *prima facie* case of obviousness in rejecting claims 1-23.
5. Whether Johnson and Geller are capable of a combination that renders claims 1-23 obvious.
6. Whether Geller teaches or suggests “a hierarchy of disposition options” as required by claims 1, 17, and 21 (and therefore by each of claims 1-23).
7. Whether Johnson or Geller teaches or suggests “at least one of said conditions being met when an asset approaches the end of a lease term,” as is required by claims 3 and 18.
8. Whether Johnson or Geller teaches or suggests a “cost variable including a comparison of a cost of leasing an asset with a threshold level representing lower cost alternatives,” as is required by claims 7 and 18.
9. Whether Johnson or Geller teaches or suggests “a manual check and confirmation of said hierarchy of options,” as is required by claims 12, 17, and 22.

VI. ARGUMENT

A. **Claims 1-23 Are Patentable Under 35 U.S.C. § 101.**

The Examiner’s basis for rejecting claims 1-23 under 35 U.S.C. § 101 was an allegation that Appellants’

claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed. Claims 1,

17, and 21 use the term “database”. However, in the context of [Applicants’] claims a database can be a notebook, or even a piece of paper. Hence, the claimed invention does not promote the progress of science and the useful arts.

(Final Office Action, page 4.) However, the provision of the United States Constitution (Article I, § 8) from which the Examiner appears to quote notwithstanding, Section 101² does not require that a claimed invention “promote the progress of science and the useful arts.” *See* 35 U.S.C. § 101. Nor does Section 101 require that a “claimed invention . . . fall within the technological arts.” *See id.* Accordingly, the Section 101 rejection of claims 1-23 should be reversed for the sole reason that the bases for the rejection are simply not supported by the plain language of Section 101.

Further, assuming *arguendo* that the Examiner has properly construed Appellants’ claims, there is no reason why a claim requiring use of a notebook or a piece of paper would not be patentable under Section 101. Appellants’ claims plainly recite systems and methods that produce useful, concrete, and tangible results, and therefore are clearly patentable under Section 101. *See State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998).

Accordingly, for any of the foregoing reasons, the Examiner’s rejection of claims 1-23 under Section 101 should be reversed.

B. Claims 12, 17, and 22 are Patentable Under 35 U.S.C. § 112.

Claims 12, 17, and 22 each recite “a manual check and confirmation of said hierarchy of options.” The Final Office Action (page 5) states that this limitation fails to meet the requirement of 35 U.S.C. § 112, second paragraph, to recite “claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” The Examiner contended that the recitation of a “manual check” is a recitation of “limitations that occur outside the system.” However, the recited manual check is clearly disclosed in paragraph 122 of Appellants’ Specification, which explains that in one embodiment “the proposed options

² Section 101 states that:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

[in a hierarchy of options] are manually reviewed.” Appellants’ Specification thus makes clear that they regarded the limitation of “a manual check and confirmation of said hierarchy of options” as being included in the subject matter that they regarded as their invention. Accordingly, the Examiner’s rejection of claims 12, 17, and 22 under Section 112 should be reversed.

C. Claims 1-23 Are Patentable Under 35 U.S.C. § 103.

Claims 1-23 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Johnson in view of Geller. Even if Johnson and Geller did teach or suggest all of Appellants’ claim limitations, which, as discussed below, they do not, the prior art of record lacks motivation to combine these references. Indeed, as is also discussed below, the Examiner failed to state any motivation to combine Johnson and Geller, nor did the Examiner demonstrate that attempting such a combination would have had a reasonable expectation of success. In fact, because Johnson teaches a system for assisting product sellers, and Geller teaches a system for assisting product purchasers, Johnson and Geller are simply incapable of combination. Accordingly, for at least the independent reasons explained below, the Section 103 rejection of claims 1-23 should be reversed.

1. Johnson Does Not Teach Or Suggest “a set of pre-defined conditions” As Required By Claims 1, 17, and 21.

Claims 1 and 17 each recite “a set of pre-defined conditions related to a recommendation of asset disposition based on an automated analysis of said information [associated with a plurality of assets] within said system.” Similarly, claim 21 recites “analyzing said information [associated with a plurality of assets] in accordance with a set of pre-defined conditions.”

Appellants’ Specification (paragraph 114) provides helpful examples of “predefined conditions”:

The pre-defined conditions include either a time variable or a cost variable. For example, one condition using a time variable involves the natural end of an asset lease – including, for example a set time period such as six (6) months prior to an end of a lease. Thus, the time variable is associated with the passage of time. A second condition using a time variable includes a situation such as when a particular asset has excessive usage compared to its time (e.g., hours) in service. An example condition using a cost variable involves an over usage of an asset, wherein based on such over usage, penalties begin to be invoked. Another example condition using a cost variable results when an analysis shows that the cost of leasing an asset appears to be higher than a threshold level when compared to other asset usage options that are immediately available to the asset user (e.g., a lessee) such as by purchasing more assets at a lower cost or reallocating existing assets between locations. It is also possible to develop pre-

defined conditions using a combination of time and cost variables. For example, an excessive usage criteria may involve both a time element and a cost element.

Contrary to the Examiner's assertion (Final Office Action, pages 5-6), Johnson nowhere teaches or suggests the forgoing claim limitations relating to "pre-defined conditions."

Johnson is directed toward a sales force automation system. (Johnson, Abstract.)

Accordingly, the portions of Johnson cited by the Examiner disclose a series of modules to aid in a product sales process, beginning with a "configuration module" used by a salesperson "to accurately configure and price a product that passes engineering, manufacturing, and customer requirements." (Johnson, 13: 46-48.) Johnson's configuration module (as well as the rest of Johnson's system used after the configuration module) has nothing to do with pre-defined conditions related to a recommendation of asset disposition. Instead, Johnson's configuration module is intended to support sales of products that might not have even been manufactured, and have not been sold or used, at the time of sale. Therefore, Johnson cannot possibly teach or suggest the recited analysis of information related to asset usage that is clearly required by claims 1, 17, and 21. Johnson at most teaches analyzing product prices, specifications, features and functions, etc., *i.e.*, descriptions of a type of product, and offers no hint of analyzing information associated with actual assets. Accordingly, the pre-defined conditions required by claims 1, 17, and 21 simply could not exist in Johnson's system.

Perhaps more importantly, Johnson does not teach or suggest any "pre-defined conditions" at all. Rather, Johnson's series of modules accept inputs and performs calculations based on those inputs. For example Johnson's "quotation module" takes into account "unit price, quantity, tradein value, discounts, fees, and taxes" and thereby "facilitates calculation and preparation of a bottom line quotation." (Johnson, 14: 22-25.) Similarly, to take another example, Johnson's "finance module" is designed "to assist the salesperson in quickly calculating and presenting finance or lease alternatives to customers based on information collected from other modules." (Johnson, 15: 17-20.) In sum, Johnson teaches at most performing pre-determined *calculations*, but nowhere suggests that those calculations depend on any pre-defined *conditions*, much less pre-defined conditions based on an analysis of information associated with a plurality of assets, as is required by claims 1, 17, and 21. And even if Johnson did disclose pre-determined conditions, Johnson contains absolutely no teaching or suggestion of

pre-determined conditions used “to determine if an action needs to be taken with respect to asset disposition.” (See Specification, paragraph 114.)

Claims 1, 17, and 21 are accordingly in condition for allowance for at least the foregoing independent reasons, as are claims 2-16, 18-20, and 22-23 depending respectively therefrom. Therefore, the Examiner’s rejection of claims 1-23 under Section 103 should be reversed.

2. Neither Johnson Nor Geller Teaches Or Suggests a “hierarchy of disposition options” As Required By Claims 1, 17, and 21.

Claims 1 and 17 recite “a hierarchy of disposition options generated by said system based on said at least one of said conditions.” Similarly, claim 21 recites “recommending asset disposition using a hierarchy of disposition options.” Johnson, as the Examiner acknowledges, does “not provide a hierarchy of options.” (Final Office Action , page 7.) Further, Geller does not cure the deficiencies of Johnson for at least three reasons. First, the Examiner has failed to meet his burden of stating a *prima facie* case of obviousness for the combination of Johnson and Geller at least because the Examiner has provided no motivation to modify Johnson with the alleged teachings of Geller. Second, Johnson and Geller are incapable of being combined to meet Appellants’ claim limitations. Third, Geller fails to teach or suggest “a hierarchy of disposition options,” and therefore even if Johnson and Geller could be combined, such a combination would not render claims 1, 17, and 21 obvious.

a. The Examiner Failed To State A *Prima Facie* Case Of Obviousness.

Section 2142 of the MPEP explains the Examiner’s burden of stating a *prima facie* case of obviousness as follows:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Here, the Examiner has simply failed to state any motivation at all to combine Johnson and Geller to meet Appellants’ claim limitations, much less point to any such motivation in the prior

art. Rather, the Examiner has simply made a rejection of the form “Johnson teaches X but not Y; Geller teaches Y; therefore it would have been obvious to combine Johnson and Geller.” (See Final Office Action, page 7.) Nor has the Examiner stated, much less shown from the prior art, that a combination of Johnson and Geller would have any reasonable expectation of success.

The Examiner has wholly failed to state a *prima facie* case of obviousness with respect to claims 1, 17, and 21. Claims 1, 17, and 21 are accordingly in condition for allowance for at least this independent reason, as are claims 2-16, 18-20, and 22-23 depending respectively therefrom.

b. Johnson and Geller Are Incapable Of Combination.

Not only has the Examiner failed to show that there would have been a reasonable expectation of success for one of ordinary skill in the art attempting to combine Johnson and Geller, but Johnson and Geller are, in fact, incapable of combination. Johnson, as noted above, discloses and claims a sales automation system designed to assist salespersons in selling products. Geller, on the other hand, teaches a system to assist shoppers in selecting products from a catalog. (Geller, Abstract, Fig. 3.) The Examiner provides no explanation of how Johnson’s system for assisting product *sellars* could be combined with Geller’s system for assisting product *purchasers*. Indeed, Johnson offers absolutely no teaching or suggestion that his system could or should be adapted for use by shoppers, rather than salespersons. Clearly, any modification of Johnson with teachings from Geller would be inoperable. That is, even if Geller did teach presenting a hierarchy of asset disposition options to a potential purchaser, which it does not, a modification of Johnson with Geller’s teaching would be pointless, because Johnson’s system does not enable use by potential purchasers. Thus, any feature from Geller imported into Johnson simply would have no effect. i.e., Johnson and Geller could not have been combined by one of ordinary skill in the art.

Claims 1, 17, and 21 are accordingly in condition for allowance for at least this independent reason, as are claims 2-16, 18-20, and 22-23 depending respectively therefrom.

c. Geller Fails To Teach “a hierarchy of disposition options.”

As noted above, claims 1, 17, and 21 each contain clear limitations requiring “a hierarchy of disposition options” for disposing of an asset. The Examiner fails to even contend that Geller anticipates these claim limitations, stating that Geller teaches “a ranking system that allows a user to rank products.” (Final Office Action , page 7.) Geller’s product ranking is clearly different from the recited “hierarchy of disposition options,” which, as Appellants’ Specification

(e.g., paragraph 129) makes clear, refers to an order of presenting, to an asset user, different options for disposing of the asset. Thus, Appellants' claims have nothing at all to do with ranking products, and, in fact, have nothing to do with ranking assets. Moreover, even if "a hierarchy of disposition options" was a ranking of dispositions, such a ranking is clearly different than a ranking of products. In sum, claims 1, 17, and 21 recite "a hierarchy of disposition options" for disposing of an asset, which is in no way taught or suggested by Geller's system for ranking products.

Claims 1, 17, and 21 are accordingly in condition for allowance for at least the foregoing independent reason, as are claims 2-16, 18-20, and 22-23, depending respectively therefrom.

3. Appellants' Dependent Claims Are Separately Patentable.

As Appellants argued in their paper filed September 14, 2004, the prior art of record fails to teach or suggest the limitations of their dependent claims. For example, as discussed herein below, claims 3, 7, 12, 18, and 22 are clearly patentable over Johnson and Geller.

a. Johnson Fails To Teach or Suggest The Limitations Of Claims 3 And 18.

Claims 3 and 18 recite "at least one of said conditions being met when an asset approaches the end of a lease term." The Final Office Action did not address this claim limitation. Further, as noted above, Johnson teaches a sales force automation system for configuring products, and managing product sales. Accordingly, Johnson does not teach or suggest anything having to do with an asset lease term, much less anything related to "conditions being met when an asset approaches the end of a lease term." Claims 3 and 18 are each separately patentable for at least this reason.

b. Johnson Fails To Teach or Suggest The Limitations Of Claims 7 And 18.

Claims 7 and 18 recite a "cost variable including a comparison of a cost of leasing an asset with a threshold level representing lower cost alternatives." Because, as noted above, Johnson provides no teaching or suggestion regarding asset leasing, Johnson cannot, and in fact does not, provide any teaching or suggestion of "a comparison of a cost of leasing an asset with a threshold level representing lower cost alternatives." Claims 7 and 18 are each separately patentable for at least this reason.

c. Johnson Fails To Teach or Suggest The Limitations Of Claims 12, 17, And 22.

Claims 12, 17, and 22 each recite “a manual check and confirmation of said hierarchy of options.” In the Final Office Action (page 7), the Examiner asserted that these claims “recite additional non-functional data as they refer to steps/process/features that occur outside the system.” Appellants respectfully suggest that the Board should reverse the rejection of claims 12, 17, and 22 under Section 103 because the basis for the rejection is unclear. The recited manual check is a limitation on how the claimed systems and method function, which limitation the Examiner apparently conceded is not found in the prior art of record. Inasmuch as the limitation is required by the plain language of the claims, it is unclear how it is “outside the system,” or how the Examiner is relieved of the obligation to cite prior art reading on the limitation. Claims 12, 17, and 22 are each separately patentable for at least this reason.

VII. CONCLUSION

In view of the foregoing arguments, Appellants respectfully submit that the pending claims are patentable under 35 U.S.C. §§ 101 and 112, and are further novel over the cited references and therefore patentable under 35 U.S.C. § 103(a). The Examiner's rejection of claims 1-23 is improper because the prior art of record does not teach or suggest each and every element of the claimed invention. In view of the above analysis, a reversal of the rejections of record is respectfully requested of this Honorable Board.

Appellants believe no fee is due with this paper. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65678-0042, from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to the above account.

Respectfully submitted,

Date: May 5, 2005

By: 
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APPENDIX A – CLAIMS ON APPEAL

A complete listing of the claims that are the subject of this Appeal is as follows.

1. An electronic system for facilitating disposition of an asset currently under lease by an asset user, comprising:
 - at least one database configured to store information associated with a plurality of assets;
 - a set of pre-defined conditions related to a recommendation of asset disposition based on an automated analysis of said information within said system, at least one of said conditions being met; and
 - a hierarchy of disposition options generated by said system based on said at least one of said conditions, wherein said conditions and said options are chosen to reduce expense by maximizing return on investment to the asset user.
2. An electronic system as recited in claim 1, wherein said pre-defined conditions include at least one of a time variable and a cost variable.
3. An electronic system as recited in claim 2, wherein said time variable comprises a passage of time, said at least one of said conditions being met when an asset approaches the end of a lease term.
4. An electronic system as recited in claim 3, wherein said options include lease renewal; asset buyout; and asset return.
5. An electronic system as recited in claim 3, wherein said time variable comprises asset usage within a predetermined period of time, said at least one of said conditions being met when asset use exceeds a usage criteria based on time in service.
6. An electronic system as recited in claim 5, wherein said options include the leasing of additional assets to reduce the amount of use of a pre-existing asset.

7. An electronic system as recited in claim 2, wherein said cost variable includes a comparison of a cost of leasing an asset with a threshold level representing lower cost alternatives.

8. An electronic system as recited in claim 7, wherein said options include the leasing of additional assets.

9. An electronic system as recited in claim 1, wherein said information includes asset identification data, maintenance history data, and lease term.

10. An electronic system as recited in claim 9, wherein said identification data comprises an asset make/model and serial number.

11. An electronic system as recited in claim 9, wherein said lease term includes at least two of a lease start date, a lease termination date, and a length of time between said lease start date and said lease termination date.

12. An electronic system as recited in claim 1, further comprising a manual check and confirmation of said hierarchy of options, wherein a rejection of said hierarchy generates feedback selectively modifying said availability of future options by said system.

13. An electronic system as recited in claim 1, wherein said options are presented to the asset user for consideration in order of expected acceptance.

14. An electronic system as recited in claim 1, wherein one of said options is a new lease, wherein upon acceptance of said new lease, a new asset is delivered to the asset user, an off-leased asset is picked up, and said off-leased asset is disposed.

15. An electronic system as recited in claim 1, wherein one of said options is a renewed lease, wherein upon acceptance of said renewed lease renewal documents are executed by the asset user.

16. An electronic system as recited in claim 1, wherein one of said options is an asset buyout, wherein upon acceptance of said asset buyout, the asset is purchased.

17. An electronic system for facilitating disposition of an asset currently under lease by an asset user, comprising:

at least one database configured to store information associated with a plurality of assets;

a set of pre-defined conditions related to a recommendation of asset disposition based on an automated analysis of said information within said system, each of said conditions comprising at least one of a time variable and a cost variable, at least one of said conditions being met;

a hierarchy of disposition options generated by said system based on said at least one of said conditions, wherein said conditions and said options are chosen to reduce expense by maximizing return on investment to the asset user; and

a manual check and confirmation of said hierarchy of options, wherein a rejection of said hierarchy generates feedback selectively modifying said availability of future options by said system.

18. An electronic system as recited in claim 17, wherein said time variable comprising a passage of time, said at least one of said conditions being met when an asset approaches the end of a lease term or when asset usage exceeds a usage criteria based on time in service; and

said cost viable including a comparison of a cost of leasing an asset with a threshold level representing lower cost alternatives.

19. An electronic system as recited in claim 17, said information including asset identification data, maintenance history data, and lease term, wherein said identification data comprises an asset make/model and serial number, and said lease term includes at least two of a lease start date, a lease termination date, and a length of time between said lease start date and said lease termination date.

20. An electronic system as recited in claim 17, wherein said options are presented to the asset user for consideration in order of expected acceptance, and wherein,

a first of said options comprises a new lease such that upon acceptance of said new lease, a new asset is delivered to the asset user, an off-leased asset is picked up, and said off-leased asset is disposed,

a second of said options is a renewed lease such that upon acceptance of said renewed lease renewal documents are executed by the asset user, and

a third of said options is an asset buyout such that upon acceptance of said asset buyout, the asset is purchased.

21. A method for facilitating disposition of an asset currently under lease an asset user, comprising the steps of:

configuring at least one database and storing information associated with a plurality of assets;

analyzing said information in accordance with a set of pre-defined conditions, each of said conditions comprising at least one of a time variable and a cost variable;

meeting at least one of said pre-defined conditions;

recommending asset disposition using a hierarchy of disposition options; and

selecting said conditions and said options by reducing expense and maximizing return on investment to the asset user.

22. A method as recited in claim 21, further comprising the step of:

instituting a manual check and confirmation of said hierarchy of options; and

said rejection of said hierarchy generating feedback, selectively modifying said availability of future options by said system.

23. An electronic system as recited in claim 21, including the further step presenting said hierarchy of options to the asset user for consideration in order of expected acceptance, and wherein,

a first of said options comprises a new lease such that upon accepting said new lease, delivering a new asset to the asset user and picking up and disposing of an off-leased asset,

a second of said options is a renewed lease such that upon accepting said renewed lease renewal, the asset user executing renewal documents, and

a third of said options is an asset buyout such that upon accepting said asset buyout, the asset user purchases the asset.

Serial No. 09/990,911
Attorney Docket No. 65678-0042

APPENDIX B – THIS BOARD’S DECISION IN RELATED CASE 09/441,289



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 38

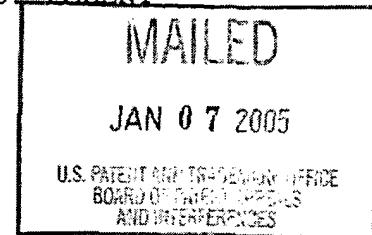
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW E. SUHY and BRENT C. PARENT

Appeal No. 2004-1971
Application No. 09/441,289

ON BRIEF



Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 16 and 21-48, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an apparatus and method for tracking physical assets. An understanding of the invention can be derived from a reading of exemplary claim 16, which is reproduced as follows:

16. A method for automatically gathering and analyzing data without human intervention relating to an asset comprising the steps of:

(a) generating a maintenance invoice from an analysis controller when service is performed on the asset, wherein the maintenance invoice includes an indication of the amount of usage of the asset, wherein said indication of the amount of usage is captured by a data acquisition device, and wherein a receiver receives the indication of the amount of usage from the data acquisition device through a transmitter;

(g) transmitting the maintenance invoice on a communication network from the analysis controller to an administrative controller;

(h) comparing on the analysis controller, the indication of the amount of usage of the asset with a predetermined standard that is representative of the warranty period; and

(I) generating a warranty report from said administrative controller without said human intervention if the amount of usage is less than the predetermined standard.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

McGuire et al. (McGuire)	4,404,639	Sep. 13, 1983
Nguyen et al. (Nguyen)	6,003,808	Dec. 21, 1999 (filed Jul. 11, 1997)
Barzilai et al. (Barzilai)	6,012,045	Jan. 4, 2000 (filed Jul. 1, 1997)
Yamamoto et al. (Yamamoto)	6,141,629	Oct. 31, 2000 (filed Jul. 13, 1998)

Sager, Business Week, "The Great Equalizer," wysiwyg://19/htp://- www.businessweek.com/1998/35/z3372007/htm (May 18, 1994)

Deierlein, Beverage World, "New Lease on truck life: Automated Maintenance" ISSN: 0098-2318, v113n1566, pp. 138 (May 1994)

Claims 16 and 43-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Deierlein, Sager, Nguyen and McGuire.

Claims 25-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Barzilai, Nguyen and McGuire.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 34, mailed December 12, 2003) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 33, filed September 11, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered.

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise,

reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we reverse.

We begin with the rejection of claims 16 and 43-48 under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Deierlein, Sager, Nguyen and McGuire. We turn first to claim 16. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins &

Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

From our review of the entire record, we note at the outset that the invoice of claim 16 does not have to be written on paper. Rather, the invoice can be displayed on a monitor. From the disclosure of Yamamoto, we find that the computer 21, which displays maintenance information such as the remaining hours until maintenance is due, is a disclosure of generating (on the monitor's display) a maintenance invoice from an analysis controller (computer 21). From the disclosure (col. 11, lines

17-23) that a determination is ordinarily made as to whether or not the user has performed maintenance, such as an overhaul or replacing consumable parts, the data is input into the computer 21, we find that the maintenance "invoice" is displayed on computer 21 when service is performed on the asset. In addition, in Yamamoto, an invoice of information regarding when maintenance is due is displayed on computer 21 when the information is sent to computer 21 by managing computer 51. In addition, as noted by appellants (brief, page 16), Yamamoto is directed to determining when maintenance should be performed, and is not directed to generating a warranty report.

From the teachings of Deierlein of accessing the truck's maintenance history, determining necessary repairs and automatically informing the technician if a repair is covered by warranty, and if so directly billing the supplier for the repair or replacement, we find that Deierlein discloses both determining needed maintenance, as well as whether the repair is covered under a product warranty, and notifying the supplier. In addition, from the disclosure of Nguyen of receiving fault codes and developing a maintenance action log and removal records, as well as a warranty report generator, we find that Nguyen also discloses determining necessary repairs and determining if a

repair is covered under a product warranty, and generating a warranty report. Because Yamamoto is directed to determining when maintenance needs to be performed, we find that an artisan, in view of the teachings of Deierlein and Nguyen, would have been motivated to provide the maintenance time determining system of Yamamoto with a system for additionally determining if a needed repair is covered by a warranty, so that the company can be repaid for the cost of the repairs. However, upon providing Yamamoto with a warranty determination system, we find that the system would be added to managing computer of network 50 of Yamamoto (see figure 12) because network 50 manages and controls the maintenance information (col. 9, lines 5-17) and updates the remaining life of the machines. We find no evidence that an artisan would have been motivated to provide the warranty determination system of Nguyen to computer 21 at monitoring station 20 of worksite 30, because computer 21 is the display location where the user inputs into the system the information as to maintenance that has been performed (col. 11, lines 17-23). Since network 50 is where the maintenance information is managed and controlled, we find that an artisan would have been motivated to add the warranty determination system at managing computer 51 of network 50. However, claim 16 recites that the analysis

controller compares the amount of usage with a predetermined standard representative of the warranty period. As the examiner relies upon elements 20 and 21 of Yamamoto as the analysis controller (answer, pages 9 and 10), we find that even if the prior art were combined as suggested by the examiner, the resultant structure would not meet all of the limitations of the claim as the comparing of usage with warranty terms would be carried out by managing computer 51 of network 50, and not by computer 21 at worksite 30. Accordingly, the rejection of claim 16, and claims 43-48, dependent therefrom, is reversed.

We turn next to the rejection of claims 21-42 under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Barzilai, Nguyen and McGuire. The examiner acknowledges (answer, page 7) that Yamamoto does not teach, inter alia, automatic determination of whether or not maintenance has been performed at the analysis controller. The examiner asserts (id.) that it would have been obvious to one of ordinary skill to allow the analysis controller to perform such a function.

From our review of Yamamoto, we find that Yamamoto discloses (col. 8, line 62 through col. 9, line 4) that:

A computer 21 having functions for coordinating the control of the vehicles within the work site 30 is installed in the monitoring station 20. This computer

21 comprises an input device for inputting information pertaining to maintenance (in-house maintenance) performed by the user in the work site 30 as will be described below, and a display device for displaying, to the user in the work site 30, maintenance information such as the remaining life until maintenance due time (remaining hours) for each of the plurality of vehicles 10, 11, ..., at the work site 30.

From this disclosure of Yamamoto, we find that at computer 21, which the examiner considers to be the claimed analysis controller, information pertaining to maintenance information performed by the user is input by the user. Because the maintenance information is input by the user, we agree with the examiner that Yamamoto does not teach that the analysis controller makes an automatic determination of whether or not maintenance has been performed. Claim 21 recites that "said analysis controller being configured for automatically determining without human intervention whether maintenance of the asset has been provided."

We are not persuaded by the examiner's assertion (answer, page 7) that "[i]t would have been obvious to one of ordinary skill to allow the analysis controller to support such a function" because the analysis controller is linked to the administrative controller. The fact that the computer 21

(analysis controller) and the network 50 (administrative controller) communicate back and forth with each other (col. 9, lines 24-30) is not a teaching of changing input by a user into an automatic determination without human intervention, as required by independent claim 21.

On pages 14 and 15 of the answer, the examiner takes the position that with respect to claim 21, the examiner considers network 50 to be the analysis controller. Irrespective of whether the examiner considers computer 21 or network 50 (having managing computer 51) to be the claimed analysis controller, the fact that the maintenance information is inputted by the user into computer 21 or computer 55 (described, supra) and then transmitted to network 50, does not teach or suggest that the input of information by the user results in the maintenance information being automatically determined, without human intervention, due to the configuration of the analysis controller.

We note the disclosure of Yamamoto (col. 12, line 63 through col. 13, line 3) that when an engine is overhauled at a maintenance plant information to this effect is input by an input device to computer 55 at the maintenance plant, and then input to managing computer 51 via global network 50. From this disclosure

cf Yamamoto, we find that input maintenance performed can be input to computer 21 or to computer 55 and then input to managing computer 51. Thus, we find that managing computer 51 does not make an automatic determination, without human input, of maintenance provided. Accordingly, neither computer 21 of monitoring station 20 nor managing computer of network 50 automatically determines, without human intervention, whether maintenance to the asset has been provided. The other references do not make up for this feature missing from Yamamoto. Accordingly, even if we combined the prior art as asserted by the examiner, the resultant combination would not meet all of the limitations of claim 21. Accordingly, we find that the examiner has failed to establish a prima facie case of obviousness of independent claim 21. The rejection of claim 21, and claims 22-30, dependent therefrom, under 35 U.S.C. § 103(a) is therefore reversed.

We turn next to independent claim 31. We reverse the rejection of claim 31 because claim 31 recites, identically to claim 21, that "said analysis controller being configured for automatically determining without human intervention whether maintenance of the asset has been provided." Accordingly, the

rejection of claim 31, and claims 32-37, dependent therefrom, is reversed.

We turn next to the rejection of claims 38-42. We observe at the outset that appellants do not provide any separate arguments for independent claim 38, and groups claim 38, inter alia, with independent claim 21. In contrast to independent claim 21, which recited that the analysis controller is configured for automatically determining without human intervention whether maintenance of an asset has been performed, claim 38 does not recite that the determination is automatic, or that the determination is done without human intervention. We note the disclosure of Yamamoto (col. 11, lines 17-19) that "[n]ext, a determination is ordinarily made as to whether or not the user has performed maintenance (in-house maintenance)." Yamamoto discloses that after the maintenance information is input, an addition point associated with the type of maintenance is added to the current score of the component (col. 11, lines 24-28). Although this determination is not automatic or done without human input, it is a determination made as a result of the configuration of computer 21. In addition, we find that as shown in figure 12 of Yamamoto, that assets 11, 12, and 13 do not necessarily communicate directly with monitoring station 10, but

rather can communicate through assets 10 and 13. In order to communicate with monitoring station 20 through assets 10 and 13, these assets will inherently contain a controller, to the extent that the controller has been broadly set forth in claim 38. In addition, we note that claim 38 does not recite a comparison related to a predetermined standard representative of a warranty period or the generation of a warranty report as recited in independent claim 16. We are not persuaded by appellants assertion (brief, page 17) that:

the claims of Claim Group B are not obvious because the cited references do not teach all of the claim limitations of Claim Group B. Omissions in the cited art that are discussed below include: (I) an analysis controller located at a second location remote from said local controller; (ii) a data acquisition device to [sic, for] sensing at least one operating characteristic; and (iii) transmitting acquired data from the acquisition device through space to said receiver.

Local controllers 10 and 13 transmit over space to monitoring station 10 which transmits over space "J" to managing and control network 50, including managing computer 51. In addition, assets 11 and 12 have data acquisition devices which transmit information to monitoring station 20 via local controllers 10 and 13. Moreover, controllers 10 and 13 transmit data acquired from acquisition devices on assets 11 and 12 to monitoring station

20, which transmits the information to network 50. We are not persuaded by appellants' assertion (brief, page 20) that no cited reference discloses an administrative controller separate from said analysis controller because claim 38, unlike independent claim 16, does not recite an administrative controller separate from the analysis controller.

Nor are we persuaded by appellants' assertion that there is no motivation for combining the references. We make reference to our findings, supra, for combining the teachings of Yamamoto and Nguyen. In addition, although claim 38 does not recite the term "warranty," the claim refers to responsible parties which we construe to mean manufacturers whose product(s) are covered by warranties. Upon providing Yamamoto with the warranty determination system of Nguyen, the managing computer 51 would be able to determine if a needed repair was covered by a warranty, and if so, which manufacturer was responsible for the cost of the warranty repair/replacement of an asset or part of an asset. However, although computer 21 may be considered to provide a determination of whether maintenance has been provided (Yamamoto col. 11, lines 17-19) managing computer 51 is not disclosed as making a determination of whether maintenance has been provided. Upon combining the teachings of Yamamoto and Nguyen, the result

would be that the warranty determination system of Nguyen would be provided in the managing computer 51 of network 50. However, claim 38 requires that the analysis controller, in addition to determining whether maintenance of an asset has been provided, also automatically determines which responsible party is responsible for the maintenance performed. Since managing computer 51 would be automatically determining the responsible party, and computer 21 would be determining if maintenance has been provided, the two computers, on separate networks, cannot be considered to be the same analysis controller. The examiner relies upon Barzilai for a disclosure of collation of data to obtain warranty data, and particularly for a teaching of the company who will fulfill and correct the warranty problem. In addition, the examiner relies upon McGuire for a disclosure of automated invoicing.

With respect to Barzilai, we find the reference to be cumulative of the disclosure of Nguyen who discloses a warranty determination system, including the generation of warranty reports, and does not overcome the basic deficiencies of Yamamoto and Nguyen. In addition, as claim 38 does not recite invoicing, we find McGuire to be cumulative to the teachings of Yamamoto, Nguyen and Barzilai. From all of the above, we find that the

prior art fails to suggest all of the limitations of independent claim 38. Accordingly, the rejection of claim 38 under 35 U.S.C. § 103(a), and claims 39-42 which depend therefrom, is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 16 and 25-48 under 35 U.S.C. § 103(a) is reversed.

REVERSED



LEE E. BARRETT
Administrative Patent Judge

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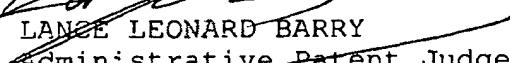
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BOARD OF PATENT
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AND
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LANCE LEONARD BARRY
Administrative Patent Judge

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STUART S. LEVY
Administrative Patent Judge

Appeal No. 2004-1971
Application No. 09/441,289

Page 17

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APPENDIX C – THIS BOARD’S DECISION IN RELATED CASE 09/653,735



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW F. SUHY, JR.

Appeal No. 2005-0013
Application No. 09/653,735

MAILED

APR 26 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-8 and 12-24, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an apparatus and method for tracking and managing physical assets. An understanding of the

invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A system for gathering and analyzing data relating to a non-fixed movable asset comprising:

a local controller located at a first location for acquiring data that is representative of at least one operating characteristic of the asset;

an analysis controller located at a second location that is responsive to said acquired data from said local controller for generating an analysis of said acquired data; and

an electronic communications network connected between said local controller and said analysis controller and permitting transmission of said acquired data from said local controller to said analysis controller; and

a sub-system that analyzes said at least one operating characteristic of the asset to determine a lease rate for the asset, the lease rate being a variable.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Koether	5,875,430	Feb. 23, 1999
Nguyen et al. (Nguyen)	6,003,808	Dec. 21, 1999 (Jul. 11, 1997)
Albertshofer	6,230,081	May 8, 2001 (Aug. 7, 1998)

Claims 1-7 and 12-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer and Nguyen.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed May 17, 2004) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 15, filed February 17, 2004) and reply brief (Paper No. 17, filed July 19, 2004) for appellant's arguments thereagainst. Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, essentially for the reasons set forth by appellant. We begin with the rejection of claims 1-7 and 12-24 under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer. We turn first to independent claims 1, 13 and 18.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings

by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, pages 5 and 6) is that Koether does not explicitly recite determining a lease rate. To overcome this deficiency of Koether, the examiner turns to Albertshofer for a teaching of an asset usage monitoring system that monitors asset performance over time for determining a lease rate. In addition, the examiner (id.) relies upon Webster's Ninth College Dictionary for a definition of "rate" which is defined as "'a quantity, amount, or degree of something measured per unit of something else'." The examiner asserts (id.) that it would have been obvious to calculate a rate based on any quantity, amount or degree of something within the scope of knowledge and understanding of an artisan, such as owners of

equipment who also maintain the equipment that they lease to others. The examiner adds that it would have been obvious to combine the systems of Koether and Albertshofer in order to accurately determine fees for the rental and leasing of capital equipment.

The examiner additionally asserts (answer, page 9) that appellant has not made clear how "rate" is defined beyond the lease rate being a variable, and that in Albertshofer the lease rate is a variable as it is based on usage. It is further argued (id.) that appellant's specification does not support as specific a definition of rate as set forth in the brief.

Appellant asserts (brief, page 9) that the prior art does not teach or suggest the claim limitation of an analysis of "at least one operating characteristic of the asset to determine a lease rate for the asset," because the prior art doesn't teach determining a lease rate as recited in claims 1, 13 and 18. It is further argued (brief, page 10) that Albertshofer teaches calculating a total lease amount based on usage duration of the vehicle or the distance it has gone, and that Albertshofer's rate is a constant independent of an operating characteristic. It is argued that Albertshofer does not teach determining a lease rate for an asset, much less determining a lease rate based on an

analysis of an operating characteristic of the assert. Appellant asserts that Albertshofer's disclosure is directed toward one-time usage of a golf cart, and that if a user rents the cart at an hourly rate of \$10, then renting it for two hours results in a total lease amount of \$20. Appellant adds that Albertshofer's rate is a constant multiplied by the variable operating characteristic, which is a usage duration, e.g., \$10 per hour. It is further asserted (id.) that in appellant's invention, the rate is a variable affected by an analysis of at least one operating characteristic. Appellant states (brief, page 11) that "Albertshofer does not teach determining a lease rate that can then be used as a variable in the calculation of the amount to be charged for a lease."

Appellant further asserts (brief, page 12) that there is no motivation to combine the teachings of Koether and Albertshofer. It is argued that "[t]he examiner provides no explanation as to why one of ordinary skill in the art would have been motivated by the cited references to analyze an operating characteristic of an asset to determine a lease rate for the asset. Moreover, the cited references provide no motivation for their combination." Furthermore, with regard to claim 18, appellant adds (id.) that neither reference discloses the claim limitation of "maintenance

information affecting said lease rate." It is argued (brief, page 13) that although Albertshofer discloses using service manuals to assist in automating vehicle maintenance, Albertshofer does not teach using maintenance information to determine a lease rate.

Upon careful review of Koether, we find the reference to be silent as to leasing of the disclosed kitchen appliances, and the examiner has failed to point to any suggestion in the reference that the kitchen appliances can be leased. Because Koether is completely silent as to leasing of the kitchen appliances, we find no teaching or suggestion to combine the teachings of Koether and Albertshofer as advanced by the examiner. However, we find Albertshofer to be closer to the claimed invention than the examiner recognized. Considering Albertshofer alone, we find that Albertshofer discloses an information system for displaying data on a golf cart (col. 1, lines 5-7). Albertshofer discloses that it is known to lease electric or engine-powered equipment in order to save on investment costs (col. 4, lines 9-12). Accounting for such services is generally done in a time-dependent fashion, or can be duty-dependent as a function of duration and intensity of use (col. 4, lines 12-15). It is

disclosed that if the duty-hour counter or distance-gone counter is tampered with, the result may be that the true wear and tear of the equipment exceeds the level as calculated by the leasing company on the basis of the information received (col. 4, lines 16-23). From the disclosure that accounting services are based on time dependency, or duration and intensity of use, and the disclosure suggesting that leases are calculated based on estimated wear and tear of the product, we find that Albertshofer teaches the determination of a lease rate by the leasing company, that is based upon operating characteristics.

In addition, from the disclosure of wirelessly transmitting collected data from the power equipment to the base station, we find teachings of a local controller on the power equipment, an analysis controller in the form of the base station, and an electronic communications network in the form of wireless communications between the power unit (golf cart) and the base station (col. 3, lines 40-43). Albertshofer additionally discloses (col. 5, lines 23-26) that "[v]ehicles, machines and equipment of all kinds, be they electrically powered, engine powered or pneumatic/hydraulically powered, as well as lifting platforms and, for instance, golf carts are suitable as

such equipment items." From the disclosure that the system can be used with a hydraulically-powered lifting platform, we find that Albertshofer suggests using the system with a forklift, as disclosed by appellant.

However, although Albertshofer teaches or suggests determining a lease rate, we find no suggestion of a sub-system in Albertshofer for carrying out the determination of the lease rate. We presume that the information gathered by the base station is somehow used by the leasing company, through their accounting methods, to determine the lease rate. However, no sub-system is disclosed for analyzing the collected data from the golf cart or other equipment and using this analyzed data in determining the lease rate. Accordingly, we find that Albertshofer alone is not sufficient to teach or suggest appellant's independent claims 1, 13 and 18 which recite a sub-system for using the operating characteristic in determining the lease rate. Thus, because Albertshofer does not disclose the claimed sub-system, Albertshofer does not teach or suggest independent claims 1, 1 and 18. The rejection of independent claims 1, 13 and 18 under 35 U.S.C. § 103(a), and claims 2-7, 14-17, 12 and 21-24, dependent therefrom, is reversed.

We turn next to the rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Koether in view of Albertshofer and Nguyen. We cannot sustain the rejection of claim 8 because the examiner has not shown, nor do we find, that Nguyen makes up for the basic deficiencies of Koether and Albertshofer. Accordingly, the rejection of claim 8 under 35 U.S.C. § 103(a) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-8 and 12-24 under 35 U.S.C. § 103(a) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a)(1)(iv) (effective September 13, 2004; Fed. Reg. 49960 (August 12, 2004)).

REVERSED

Lee E. Barrett
LEE E. BARRETT
Administrative Patent Judge

LEE E. BARRETT
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

Administrative Patent Judge

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